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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,057	04/27/2001	Anthony S. Volpe	VAK-PT005.1	2706

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UNITED PLAZA, SUITE 1600
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EXAMINER

FLANDERS, ANDREW C

ART UNIT PAPER NUMBER

2644

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/844,057		VOLPE ET AL.	
	Examiner		Art Unit	
Andrew C. Flanders		2644		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 1 - 24 have been considered but are moot in view of the new ground(s) of rejection necessitated by Applicant's amendment.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 3, 7 – 17 and 20 – 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorbet (U.S. Patent 6,072,480) in view of Raspberry World Music (herein after referred to as RWM; <http://www.raspberryworld.com/music/burned.html>).

Regarding **Claim 1**, Gorbet discloses:

A virtual DJ (i.e. a mechanism for playing custom music soundtracks to accompany an electronic slide show; col. 3 lines 66 – 67 and col. 4 line 1), comprising:
media capable of recording information to be played at a future event (i.e. during a subsequent (*future*) slideshow, the invention automatically retrieves the information and dynamically creates a music soundtrack that plays the music corresponding to the displayed slide; col. 4 lines 5 – 12).

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Gorbet doesn't explicitly disclose a collection of client related material fixed on the media.

RWM discloses creating a CD Mix (*music soundtrack*) for a Birthday with songs that remind us of different times in our lives, places we've gone, or things we've done; (see Songs for a Rocket Man). RWM further discloses making a CD for a friend that reminds me of her, or things we've done, or things we like (see Maria-Mania!).

Applying this play list creation technique to the slide show soundtrack disclosed by Gorbet would read upon the limitation of client related material fixed on the media.

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the play list creation technique to Gorbet's slideshow. One would have been motivated to do so to create a more meaningful slideshow filled with various memories.

The combination further discloses

DJ performance materials complementarily arranged with and contemporaneously fixed on the recording media with the client related material (i.e. the specification material is automatically saved and associated with the slide presentation; col. 4 lines 5 – 10 in Gorbet).

Regarding **Claim 2**, in addition to the elements stated above regarding claim 1, the combination of Gorbet in view of RWM further discloses:

wherein the media is an audio media (i.e. the soundtrack; col. 8 lines 7 – 18 in Gorbet).

Regarding **Claim 3**, in addition to the elements stated above regarding claim 1, the combination of Gorbet in view of RWM further discloses:

wherein the media is audio and visual (i.e. the specification information is automatically saved and associated with the slide presentation; col. 4 lines 5 - 10 in Gorbet).

Regarding **Claims 7 and 8**, in addition to the elements stated above regarding claim 3, the combination of Gorbet in view of RWM further discloses:

wherein the media includes pictures for display at the future event (i.e. the slide show col. 4 lines 5 – 10 in Gorbet).

Regarding **Claim 9**, in addition to the elements stated above regarding claim 1, the combination of Gorbet in view of RWM further discloses:

wherein the media includes songs from a play list (i.e. the user selects one of three custom soundtrack options; col. 8 lines 15 – 20 in Gorbet).

Regarding **Claim 10**, in addition to the elements stated above regarding claim 1, the combination of Gorbet in view of RWM further discloses:

wherein the client related material includes guest information (i.e. songs that remind of us different times in our lives; Songs for a Rocket Man and Maria-Mania! In RWM).

Regarding **Claim 11**, in addition to the elements stated above regarding claim 1, the combination of Gorbet in view of RWM further discloses:

wherein the media includes software to enable a display of visual effects synchronized with audio portions of the DJ performance materials (i.e. playing music corresponding to the currently displayed slide; col. 4 lines 10 – 14 in Gorbet).

Regarding **Claims 12, 20 and 23**, Gorbet discloses:

A method for performing recorded material at a future event (i.e. during a subsequent (*future*) slideshow, the invention automatically retrieves the information and dynamically creates a music soundtrack that plays the music corresponding to the displayed slide; col. 4 lines 5 – 12).

Gorbet does not explicitly disclose gathering client related material associated with the future event.

RWM discloses creating a CD Mix (*music soundtrack*) for a Birthday with songs that remind us of different times in our lives, places we've gone, or things we've done; (see Songs for a Rocket Man). RWM further discloses making a CD for a friend that reminds me of her, or things we've done, or things we like (see Maria-Mania!).

Applying this play list creation technique to the slide show soundtrack disclosed by Gorbet would read upon the limitation of gathering client related material associated with the future event.

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It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the play list creation technique to Gorbet's slideshow. One would have been motivated to do so to create a more meaningful slideshow filled with various memories.

The combination further discloses:

producing a recorded performance by complementarily and contemporaneously arrange a DJ's performance material with the gathered client related material (i.e. the specification material is automatically saved and associated with the slide presentation; col. 4 lines 5 – 10 in Gorbet);

storing the recorded performance on media; and playing the recorded performance at the future event (i.e. during a subsequent (*future*) slideshow, the invention automatically retrieves the information and dynamically creates a music soundtrack that plays the music corresponding to the displayed slide; col. 4 lines 5 – 12).

Regarding **Claim 13**, in addition to the elements stated above regarding claim 12, the combination of Gorbet in view of RWM further discloses:

wherein the gathering of client related material is in response to a play list and guest information (i.e. the mix is created for a birthday based upon things that remind us of different times places or things we've done; Songs for a Rocket Man in RWM).

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Regarding **Claim 14**, in addition to the elements stated above regarding claim 13, the combination of Gorbet in view of RWM further discloses:

wherein the guest information includes stores and idiosyncrasies (i.e. the mix is created for a birthday based upon things that remind us of different times places or things we've done; Songs for a Rocket Man in RWM)

Regarding **Claim 15**, in addition to the elements stated above regarding claim 12, the combination of Gorbet in view of RWM further discloses:

wherein the complementary arrangement of the recorded performance is based on in part an itinerary (i.e. the CD is made for a birthday; Songs for a Rocket Man in RWM).

Regarding **Claim 16**, in addition to the elements stated above regarding claim 12, the combination of Gorbet in view of RWM further discloses:

an event client providing pertinent information regarding the future event (i.e. the mix is created for a birthday based upon things that remind us of different times places or things we've done; Songs for a Rocket Man in RWM).

Regarding **Claim 17**, in addition to the elements stated above regarding claim 12, the combination of Gorbet in view of RWM further discloses:

providing an event client the recorded performance in a recording media (i.e. giving the CD to the person that the mix is created for ; all of RWM).

Regarding **Claim 21**, in addition to the elements stated above regarding claim 20, the combination of Gorbet in view of RWM further discloses:

wherein said gathering means includes an Internet web site having an input configured to receive client related material provided by an event client (i.e. means for connecting to the internet; col. 5 line 49; and in a networked environment, program modules depicted relative to the personal computer, or portions thereof, may be stored in the remote memory storage device; col. 5 lines 50 – 53 in Gorbet).

Regarding **Claim 22**, in addition to the elements stated above regarding claim 20, the combination of Gorbet in view of RWM further discloses:

wherein the playing means includes a computer (i.e. the personal computer; col. 5 line 30)

Claims 4, 18 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorbet (U.S. Patent 6,072,480) in view of Raspberry World Music (herein after referred to as RWM; <http://www.raspberryworld.com/music/burned.html>) and in further view of Bakos (U.S. Patent 6,511,728).

Regarding **Claims 4, 18 and 24**, in addition to the elements stated above regarding claims 1, 17 and 23, the combination of Gorbet in view of RWM further

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discloses: In Gorbet, an optical drive for writing to an optical disk such as a CD-ROM; col. 4 lines 55 – 60. Gorbet doesn't explicitly disclose storing the slide show to the CD-ROM. However, given the means of recording to a non-volatile CD-ROM, it would have been obvious to one of ordinary skill in the art at the time of the invention to record the slide-show onto a CD-ROM. One would have been motivated to do so in order to increase the portability of the slide show presentation.

Furthermore, the combination doesn't disclose wherein the media has a predetermined life span.

Bakos discloses an optical media that can only be used for a limited period of time; col. 2 lines 63 – 67.

It would have been obvious to one of ordinary skill in the art at the time of the invention to record the slide show onto a CD with a limited life as disclosed by Bakos. One would have been motivated to do so in a situation where the slide show on the CD was a demo; see Bakos lines 45 – 50.

Claims 5, 6 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorbet (U.S. Patent 6,072,480) in view of Raspberry World Music (herein after referred to as RWM; <http://www.raspberryworld.com/music/burned.html>).

Regarding **Claims 5 – 6**, in addition to the elements stated above regarding claim 1, the combination of Gorbet in view of RWM further discloses: In Gorbet, an

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optical drive for writing to an optical disk such as a CD-ROM; col. 4 lines 55 – 60.

Gorbet doesn't explicitly disclose storing the slide show to the CD-ROM. However, given the means of recording to a non-volatile CD-ROM, it would have been obvious to one of ordinary skill in the art at the time of the invention to record the slide-show onto a CD-ROM. One would have been motivated to do so in order to increase the portability of the slide show presentation.

Regarding **Claim 19**, in addition to the elements stated above regarding claim 17, the combination of Gorbet in view of RWM fails to disclose accepting a security deposit from the event client prior to the step of providing. However, Examiner takes official notice that taking a security deposit prior to providing goods or services is notoriously well known in the art. One would have been motivated to accept a security deposit prior to the step of providing in order to ensure the items given out were returned in a usable condition.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. McCullough (U.S. Patent 5,539,658), Chailleux (U.S. Patent 6,404,441), Merrill (U.S. Patent 6,789,228), Wisnudel (U.S. Patent 6,925,051), Amir (U.S. Patent 6,636,238) and Lin (U.S. Patent 6,369,835).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew C. Flanders whose telephone number is (571) 272-7516. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on (571) 272-7848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

acf



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